

DOCKET NO.: 210295US



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF : GROUP ART UNIT: 2814

Tomasz L. Klosowiak et al. :

SERIAL NO.: 09/897,059 : EXAMINER: Wille

FILED: July 3, 2001 :

FOR: STRUCTURE AND METHOD FOR FABRICATING SEMICONDUCTOR  
STRUCTURES AND DEVICES UTILIZING THE FORMATION OF A COMPLIANT  
SUBSTRATE FOR MATERIALS USED TO FORM THE SAME AND PIEZOELECTRIC  
STRUCTURES HAVING CONTROLLABLE OPTICAL SURFACES

RESTRICTION RESPONSE

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

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Responsive to the Restriction Requirement dated October 15, 2002, Applicants elect Group I, Claims 1-16.

REMARKS

The claims in this case were restricted into two Groups. Applicants have provisionally elected Group I, Claims 1-16 for initial prosecution. The Restriction Requirement is traversed.

The Office Letter characterizes the two Groups of claims as being related as "process of making and product made." Referring to MPEP §806.05(f), the Office Letter takes the position that, rather than epitaxy, the compound semiconductor could be formed as a separate substrate and be bonded to remaining layers on a second substrate. While not taking a position with regard to the Examiner's comments, Applicants submit that the statement in the

Office Letter does not meet the requirements set out in MPEP §806.05(f).

In this case there is no explanation in the Restriction Requirement as to why the proposed alternative would be *materially different* processes, as that term is used in the MPEP to support Restriction, nor is there an explanation as to how or why the proposed alternative process would provide the device structure of, e.g., Claim 1. Applicants thus respectfully submit that the Restriction Requirement fails to make out a *prima facie* case supportive of Restriction, and for this reason Applicants request that the Requirement be withdrawn and that all claims in this case be examined.

In addition, for a Restriction to be proper a burden must be placed on the Office in examining all claims. Here, a full search of all pending claims would entail the search of only a few subclasses, and thus Applicant respectfully submits that a full search of this case would not present the necessary burden.

Finally, Applicants note that the provisionally non-elected claims are method claims, and thus rejoinder is respectfully requested. The Examiner is authorized to make the process claims depend from appropriate device claims if necessary for rejoinder and allowance on first action. See MPEP §821.04.

Respectfully submitted,

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